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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,650	04/18/2001	David Gilbert	KONN-01000US0	9124
28554	7590	06/15/2006	EXAMINER	
VIERRA MAGEN MARCUS & DENIRO LLP 575 MARKET STREET SUITE 2500 SAN FRANCISCO, CA 94105			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/837,650

Applicant(s)

GILBERT ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite the phrase “transferring...the preferred defined contribution plan”. It is unclear how a preferred defined contribution plan could be transferred. It may be that information related to such a plan resulting from the method could be transferred, but the transfer of the plan itself is confusing. It is assumed for purposes of examination that Applicant intends the concept of transfer of results of method execution.

**Claims 13 and 24-25** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite the phrase “providing a preferred defined contribution plan in response to the plurality of preference values and the plurality of rank values”. It is unclear how a preferred defined contribution plan could be provided. It may be that information related to such a plan resulting from the method could be transferred, but the providing of the plan itself is confusing. It is assumed for purposes of examination that Applicant intends the concept of transfer of results of method execution.

**Claim 11** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. It recites the phrase “a cost to company category”. The phrasing is unclear and the Specification provides no further detail.

The Claims have been examined to the best of the Examiner’s ability, given the state of the Claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8, 12-17 and 20-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mutual fund performance appraisals: a multi-horizon perspective with endogenous benchmarking*, hereinafter, *appraisals* in view of US 6,601,044 *Wallman*.

**As to Claim 1**, *appraisals* discloses the invention substantially as claimed, including in a method for identifying a preferred defined contribution plan, steps of:

(a) receiving a plurality of preference values associated with a respective plurality of performance categories (page 244, Fig1. and related text);

(b) scoring a plurality of defined contribution plans, wherein a first defined contribution plan includes the plurality of performance categories and a respective plurality of performance category scores (page 252, see “Types of Return” (performance categories) and “Scores” (performance category scores));

(c) ordering the plurality of defined contribution plans by the plurality of performance category scores (page 253, Table 6);

(d) assigning a plurality of rank values to the respective plurality of defined contribution plans corresponding to the respective plurality of performance category scores (page 253, Table 6).

See also pages 248-254.

*appraisals* does not specifically disclose that the various steps are performed by a broker processing device and a central processing device, or the transfer of the results of the method to a broker processing device. *Wallman* discloses a broker processing device (Fig. 14, ele. 11; Col. 40, line 60 to Col. 41, line 16; Col. 21, lines 53-59), a central processing device Fig. 14, ele. 62; Col. 40, line 60 to Col. 41, line 16) and transfer of the results of the method to a broker processing device (Col. 40, line 60 to Col. 41, line 16). See also Col. 27, line 63 to Col. 28, line 9). It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *appraisals* to utilize the computer infrastructure of *Wallman* because this would provide technology to perform the method and transfer a useful result (ranking of plans) to a potential investor.

As to Claim 2, *Wallman* discloses a 401(k) plan at Col. 10, lines 9-31 and Col. 14, line 58 to Col. 15, line 4.

Regarding Claim 3, *appraisals* discloses performance of investments throughout the document.

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**With Respect to Claim 4,** *Wallman* discloses a graphical user interface at Col. 13, lines 39-60.

**With Respect to Claim 5,** *Wallman* discloses entry by a broker at Col. 21, lines 21-62. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify the process of *appraisals* with the broker entry of *Wallman* because this would allow a financial professional access to plan selection techniques.

**Regarding Claim 6,** *appraisals* does not specifically disclose the recited plan characteristics. Official Notice is taken that these were old and well known aspects of defined contribution plans at the time of the invention. For example, it was common for investment plans to tout that they had “\$XXX Billion dollars of investor assets under management”. It would have been obvious to one of ordinary skill in that art at the time of the invention to include these characteristics in plan selection processes because this would factor plan strength into the processes.

**Regarding Claim 7,** *appraisals* discloses plan ranking numbers between 1 and 5 at page 253, Table 6.

**Regarding Claim 8,** see the discussion of Claim 5 and *Wallman* discloses a plan sponsor providing plan characteristics at Col. 14, line 58 to Col. 116, line 22 and Col. 32, lines 12-20.

**With Respect to Claim 12,** *Wallman* discloses filtering by the central processing device at Col. 41, line 60 to Col. 41, line 16.

**As to Claim 13,** see the discussion of Claim 1, which is a superset of Claim 13. *Wallman* likewise discloses the system elements at Fig. 14 and related text.

**With Respect to Claim 14**, it is a system variant of Claim 1 and is rejected in a like manner. As to hardware and software components recited, see *Wallman* at Summary of the Invention.

**With Respect to Claim 15**, *Wallman* discloses a database of investment plans at Fig. 1, ele. 6 and Col. 23, lines 10-43.

**Regarding Claim 16**, *appraisals* does not specifically disclose the broker ID numbers. Official Notice is taken that these were old and well known aspects of defined contribution plans at the time of the invention. For example, it was necessary for brokers to be registered with licensing authorities. It would have been obvious to one of ordinary skill in that art at the time of the invention to include these numbers because this would provide unique identification to brokers.

**As to Claims 17 and 20-24**, see the discussion of Claims 1, 2, 4, 5, 6 and 1 respectively.

**Regarding Claim 25**, *appraisals* discloses comparison at Table 6.

**Claims 9-10, 18 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mutual fund performance appraisals: a multi-horizon perspective with endogenous benchmarking*, hereinafter, *appraisals* in view of US 6,601,044 *Wallman* and further in view of US 5,844,817 *Lobley et al.*

**Regarding Claims 9 and 10**, *appraisals* discloses the invention substantially as claimed. See the discussion of Claim 1. *appraisals* does not specifically disclose the product of plural preferences (weights) and ranks to make a selection. *Lobley* discloses this limitation at Fig. 4

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and Col. 6, line 64 to Col. Col. 9, line 28. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *appraisals* with the decision making methodology of *Lobley* because this would provide a structured method for plan selection considering the importance of various characteristics of plans.

**Regarding Claims 18-19**, see the discussion of Claims 17 and 9-10.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

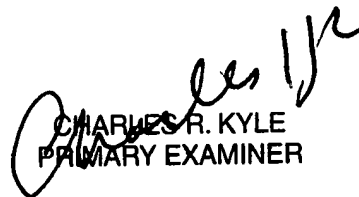
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

crk  
June 8, 2006

  
CHARLES R. KYLE  
PRIMARY EXAMINER